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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/695,621	10/28/2003	Stefan Kiefer	13914-016001 / 2003P00626	3903
32864 7590 09/16/2008 FISH & RICHARDSON, P.C. PO BOX 1022 MINNEAPOLIS, MN 55440-1022			EXAMINER FADOK, MARK A	
			ART UNIT 3625	PAPER NUMBER
			NOTIFICATION DATE 09/16/2008	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PATDOCTC@fr.com

Office Action Summary	Application No. 10/695,621	Applicant(s) KIEFER ET AL.	
	Examiner MARK FADOK	Art Unit 3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 July 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) 1-12 and 16-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13-15, 21-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7/2/2008 has been entered.

Examiner's Note

Examiner has cited particular columns and line numbers or figures in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1 and 28, the structure of the claim does not indicate which if any of the steps are being accomplished using a computer. Further, based on Supreme Court precedence see *Diamond v Diehr* 450 US 175,184 (1981); *Parker v. Flook*, 437 US 584,588,n. 9 (1978); *Gottschalk v Benson*, 409 US 63, 70 (1972); *Cochrane v Deener*, 94 US 780, 787-88 (1876) a 101 process must (1) be tied to another statutory class (such as an apparatus) or transform underlying subject matter (such as an article or materials) to a different state or thing. Since neither of these requirements is met by the claim the claim is rejected as being directed to non-statutory subject matter.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The terms “term set” and “price set” are not defined in the specification. Therefore the examiner cannot contemplate the scope of the claim.

Claim Rejections - 35 USC § 103

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 13-15 and 21,23-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Davis et al (2006/0149653) in view of Kendal et al (US PG PUB 20030191672).

In regards to claim 13, Davis discloses a computer-implemented method of managing bid pricing information, comprising: receiving transaction information and item data from a buyer (FIG 19);

generating a bid invitation containing entries relating to the transaction information and item data (FIG 19), and

making the bid invitation available to a plurality of potential bidders (FIG 19, item 605);

receiving from one or more of the potential bidders bid responses containing a complex pricing structure and corresponding complex pricing amounts (FIG 19A);

wherein the complex pricing structure is selected and supplied by each potential bidder (para 0010) and

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the complex pricing structures supplied by two or more potential bidders include bids with multiple different pricing amounts. (para 0019, 0034 and 0037,00148) applicant's specification defines complex pricing in terms of discount pricing, see applicant's specification PG PUB 20050091122, para 0028 for a definition of complex pricing that includes volume discounts), since these complex pricing scenarios are distributed to others when an auction is reopened to allow other suppliers to provide the same complex bidding (Davis, para 0019) the limitation of at least two bidders providing multiple different pricing amounts is taught by Davis. Applicant may argue that the different discounts are not specifically noted as prices but terms, however as is clear in para 0034, 0035 and 0148 of Davis, costs of the product provide in a complex pricing when scenarios are run applying the different scenarios and resulting in a variable cost/price or complex pricing.

Davis teaches providing proposals from a bidder (proposal with a terms and a corresponding price, but does not specifically mention that there is a "set of prices" (from applicant's specification) that are set up for the proposal. The examiner takes official notice that providing a proposal with terms that include process that vary over time for setting up a long term contract proposal where the prices escalate over time was old and well known in the art at the time of the invention. It would have been obvious to a person having ordinary skill in the art at the time the invention to include in Davis providing a proposal with complex pricing including variable price sets, because these types of contracts are well known in the art and are used to adjust pricing over a longterm

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contract and including this in a proposal will open the system up to very valuable long term contracts that can add increased functionality and revenue.

Further Davis does not specifically mention that each bidder provides multiple different proposals with each proposal. However, Kendal teaches sending in multiple proposals for a single bid (Kendal para 0083). It would have been obvious to a person having ordinary skill in the art at the time of the invention to include in Davis and Official Notice each bidder provides multiple different proposals with each proposal as is taught by Kendall, because multiple rating can be generated with multiple prices and can therefore increase the likelihood of providing the winning bid. and

selecting a winning bidder based at least in part on the complex pricing amounts (FIG 19B).

In regards to claim 14, the combination of Davis, Official Notice and Kendall teach wherein a complex pricing structure from a first bidder is made available for review by other potential bidders (FIG 19B, item 627).

In regards to claim 15, the combination of Davis, Official Notice and Kendall teach wherein complex pricing amounts from a first bidder are made available for review by other potential bidders (FIG 19B, item 627).

In regards to claim 21, the combination of Davis, Official Notice and Kendall teach wherein the complex pricing structure comprises date-based pricing information (FIG 19B, item 614).

In regards to claim 22, the combination of Davis, Official Notice and Kendall teach wherein the bid response from a first bidder of the plurality of bidders contains multiple bid prices for a particular item, with each bid price being associated with different terms identified and specified by the bidder (see reponce to claim 13).

In regards to claim 23, the combination of Davis, Official Notice and Kendall teach providing the different bid terms from the first bidder, but not the bid prices, to the plurality of bidders other than the first bidder, and seeking bid prices from the plurality of bidders other than the first bidder for the different bid terms (para 0156).

In regards to claim 24, the combination of Davis, Official Notice and Kendall does not specifically teach wherein the different terms and the bid prices correspond to geographic location-specific information. It would have been an obvious matter of design choice to include the different terms and the bid prices correspond to geographic location-specific information using the system of Davis, Official Notice and Kendall, because the applicant has not disclosed that limiting the purchasing system of Davis, Official Notice and Kendall to only different terms and the bid prices correspond to

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geographic location-specific information solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well using any term.

In regards to claim 25, the combination of Davis, Official Notice and Kendall teach wherein the multiple different pricing amounts comprise multiple prices from a particular bidder for a particular bid item (Kendal, para 0083).

In regards to claim 26, the combination of Davis, Official Notice and Kendall teach aggregating bids received from the plurality of bidders when a bidding period has ended (FIG 21).

In regards to claim 27, the combination of Davis, Official Notice and Kendall teach normalizing prices of the aggregated bids to permit comparison among differing bids (FIG 21).

In regards to claim 28, the combination of Davis, Official Notice and Kendall teach a computer-implemented method of managing bid pricing information, comprising: receiving from an owner transaction information regarding an item on which the owner seeks bids;

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generating a bid invitation including the information regarding the item and making the bid invitation available to a plurality of potential bidders;

receiving from a first bidder a plurality of bid proposals, where each bid proposal is characterized by a pricing set and a term set corresponding to the pricing set; and

selecting a winning bidder based on the pricing sets and corresponding term sets (see response to claim 13).

In regards to claim 29, the combination of Davis, Official Notice and Kendall teach making the terms of the bid response received from the first bidder, available to other of the potential bidders, and receiving prices from at least some of the other potential bidders (para 0156)

In regards to claim 30, the combination of Davis, Official Notice and Kendall teach concealing from the other potential bidders the prices bid by the first bidder (para 0156)

In regards to claim 31, the combination of Davis, Official Notice and Kendall teach aggregating the bid prices for common terms to permit comparison among different bids (FIG 21).

Response to Arguments

Applicant's arguments with respect to claims 13-15,21-31 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Mark Fadok** whose telephone number is **571.272.6755**. The examiner can normally be reached Monday thru Friday 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Jeffrey A. Smith** can be reached on **571.272.6763**.

Any response to this action should be mailed to:

Commissioner for Patents

P.O. Box 1450

Alexandria, Va. 22313-1450

or faxed to:

571-273-8300

[Official communications; including
After Final communications labeled
"Box AF"]

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For general questions the receptionist can be reached at

571.272.3600

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/Mark Fadok/

Primary Examiner, Art Unit 3625